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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,669	02/24/2000	Ulrike Jeck-Prosch	32140-153023	5754

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EXAMINER

CLEVELAND, MICHAEL B

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No. 09/512,669	Applicant(s) JECK-PROSCH ET AL.
Examiner Michael Cleveland	Art Unit 1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See attached.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 43-56.

Claim(s) withdrawn from consideration: 1-9 and 57-59.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

DETAILED ACTION

1. The proposed After Final amendment would be entered upon the filing of a timely filed appeal brief in support of a Notice of Appeal. The response would resolve most of the rejections under 35 USC 112, 2nd paragraph. (See below.) The rejections under 35 USC 102 and 103 would remain unchanged.

Response to Arguments

2. Applicant's response and amendment substantially overcomes the rejections under 35 USC 112, 2nd paragraph of claims 47-50, 53, and 55-56. However, claim 44 remains rejected under this ground because it is unclear if the "providing" step is in addition to the "providing" step of parent claim 43, or whether a single providing step meets the limitation of both claims. If the latter, then examiner recommends deleting the redundant "providing" clause from claim 44. (Applicant did not address this issue in the response, but applicant's other remarks regarding the rejections of claim 44 under 35 USC 112, 2nd were convincing.)

3. Applicant's arguments filed 2/24/2003 have been fully considered but they are not persuasive.

Applicant argues that Willer '325 does not anticipate because Menke was cited in the rejection, and that such violates the procedure of MPEP 2131. The argument is unconvincing because multiple references may be used where the purpose of the extra reference is to "[e]xplain the meaning of a term used in the primary reference." See MPEP 2131.01. Menke is cited merely to explain that the terms "HMX" and "RDX" taught by Willer, mean "octogen" and "hexogen", respectively.

In response to applicant's argument that Willer related to large launch vehicle propellants rather than gun ammunition, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues that PGN is a liquid, as evidenced by col. 6, line 40 of Willer. The argument is unconvincing because the claims do not require the contacting polymer to be solid.

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Applicant argues that col. 3, lines 10-24 and col. 5, line 54-col. 6, line 2 and col. 8 "reveals no description... which relate to surface treating of particulate matter." The argument is incorrect. Col. 8 teaches mixing (i.e., surface treating) a propellant (ammonium nitrate) with other materials, and col. 5, lines 55-67 teaches that the propellant is in particulate form.

Applicant argues that Lutz does not describe admixing a propellant and the at least two nitramines. However, applicant admits immediately above that it teaches admixing nitrocellulose with the alkyl NENAs. Nitrocellulose is a propellant, as disclosed and claimed by applicant. Therefore, Lutz does teaching admixing a propellant and the nitramines.

Applicant argues that Lutz does not make up for the difference in O'Meara because Lutz teaches colloids. The argument is unconvincing because it does not address the clearing teaching of Lutz to substitute alkyl NENAs for nitroglycerin for use in propellants.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (703) 308-2331. The examiner can normally be reached on 8-5:30 M-F, with alternate Mondays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-3186 for regular communications and (703) 306-3186 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



MBC

March 13, 2003



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